

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/725,355 Confirmation No.: 1296
Applicant(s): Seymour et al.
Filed: December 1, 2003
Art Unit: 1791
Examiner: Dennis R. Cordray
Title: CIGARETTE PAPER TESTING APPARATUS AND ASSOCIATED METHOD

Docket No.: 030627/268881
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 CFR § 41.41

This Reply Brief is being submitted within two months of and in response to the “Examiner’s Answer” mailed October 1, 2008. These comments are an extension of, and in addition to, the arguments presented in the Supplemental Appeal Brief filed July 25, 2008.

In response to Section 10, entitled Response to Argument, of the Examiner’s Answer, Applicants submit that Examiner’s assertions regarding pending Claims 1-3, 5-12, 14-19, 22-29, and 31 **are incorrect** for the various reasons presented below.

- I. In rejecting Claims 1-3, 5-6, 8-12, 14-15, 17-19, 22-23, 25-29 and 31 under 35 U.S.C. §103(a), the Final Office Action fails to consider the claimed invention as a whole, as required by MPEP 2141.02(II).

As argued previously in the Supplemental Appeal Brief, the Examiner’s assertions fail to consider the claimed invention as a whole. That is, Claims 1, 10, 18, and 28 particularly recite a pattern detection device disposed between the first and second

bobbins and configured to detect at least one of the bands and produce **a band detection signal** in response thereto. A testing device in communication with the pattern detection device and disposed serially therewith, between the first and second bobbins, is configured to **nondestructively measure at least one of a porosity and a basis weight** of at least one of the bands **in contemporaneous response to the band detection signal, while the cigarette paper is between the first and second bobbins** and before the cigarette paper is wound on the second bobbin.

In contrast, as previously described in the Supplemental Appeal Brief, the Bokelman '218 patent discloses an optical inspection system for inspecting the paper which generate **data indicative of the spacing between bands, the width of the bands, and the contrast of the bands**, but **does not** teach or suggest that any of the inspection stations **generates a band detection signal** upon inspection of the paper, **wherein that band detection signal is used to contemporaneously trigger a testing device**. Further, the Seymour '547 reference discloses "equivalent means for determining the location of the bands" vis-à-vis a band detection system in the context of a **cigarette manufacturing process**, which is **not relevant** to a testing device in a system directed to the examination of a cigarette paper used in the manufacture of a cigarette, and **does not** teach or suggest any "testing device" for the cigarette paper. Finally, the Cholet '560 reference discloses a permeability testing device used to run a first test to determine the periodicity of the bands of a paper, wherein the same device is then subsequently used to run a second test that uses the determined periodicity in order to perform permeability tests along the paper.

In this regard, Applicants thus submit that the Bokelman '218 patent **does not** disclose any **band detection signal** generated by a pattern detection device for **contemporaneously** triggering a testing device to perform a **porosity and/or basis weight measurement** of a band of a banded cigarette paper. Further, the Cholet '560 reference **does not** teach or suggest implementing **separate and discrete** testing and pattern recognition devices, or a testing device configured to contemporaneously respond to a band detection signal generated by a pattern recognition device. In addition, the Seymour '547 reference does not disclose any "testing device" or any applicability of a

band detection system to a testing device in a cigarette paper examination process. In this regard, the Applicants reiterate that the pattern detection device and the testing device recited by Claims 1, 10, 18, and 28 are **individual elements** that are **serially disposed such that the bands of the cigarette paper are detected by the pattern detection device, which generates a band detection signal, and the porosity and/or basis weight of a band is measured by the testing device in contemporaneous response to the band detection signal communicated thereto by the pattern detection device, as the paper is advanced through those serially disposed elements.** In this regard, by attempting to combine the teachings of the cited references, the Final Office Action fails to consider the claimed invention as a whole.

Further, the Examiner's Answer alleges that "saving time and money are powerful and universal motivators for making changes to a process or apparatus." Examiner's Answer at p. 9, lines 13-14. The Applicants respectfully submit that such an alleged universal motivator in and of itself does not provide, in this instance, an **objective reason to combine the teachings of the references**. That is, the Final Office Action does not provide a sufficient motivation to combine the references because the alleged combinations (and complexities of the combinations) do not predictably present solutions in that the motivation to save time and/or money presents infinite possibilities for modification. Thus, in light of the stated differences between the references cited in the Final Office Action and the claimed invention, and further due to the failure of an objective and sufficient reason to combine the teachings of the references, the Applicants submit that it would not have been obvious to one of ordinary skill in the art to combine the complex teachings of the cited references to arrive at the claimed invention. Further, in response to the Examiner's quotation and citation of *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971), Applicants respectfully submit that in this instance the judgment on obviousness asserted by the Final Office Action does improperly "include knowledge gleaned only from applicant's disclosure," as previously described.

As such, the Applicants submit that the Bokelman '218, Cholet '560, and Seymour '547 references, either separately or in combination, **do not** teach, suggest,

provide motivation for, or otherwise render predictable the embodiments of the present invention as now claimed in Claims 1, 10, 18, and 28. Claims 1, 10, 18, and 28 now pending are therefore patentable over the Bokelman '218, Cholet '560, and Seymour '547 references, in addition to Claims 2, 3, 5-6, 8-9, 11, 12, 14-15, 17, 19, 22-23, 25-27, 29, and 31 which depend therefrom.

II. The Final Office Action relies upon impermissible hindsight in combining the cited references to arrive at the invention claimed presently in Claims 1-3, 5-6, 8-12, 14-15, 17-19, 22-23, 25-29 and 31.

The Applicants further submit that the Office Action has impermissibly used hindsight and the teachings of the present application to reject the pending claims as being obvious over the cited references. See *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966) (discussing the “importance of guarding against hindsight ... and resist[ing] the temptation to read into the prior art the teachings of the invention in issue” when considering the obviousness of a patent). In this instance, it appears that the Office Action has simply retraced the path of the Applicants with hindsight, discounted the number and complexity of the alternatives that would have been possible for simply saving time and/or money in the process of testing/manufacturing cigarettes, and concluded that the invention as claimed was obvious. That is, if the initial goal of the Applicants was to save time and/or money in examining a length of a cigarette paper, then there would have been an infinite amount of possible improvements to consider. In this regard, contrary to the allegations of the Examiner, the combination of elements in the claimed invention would not have been predictable. To that end, only impermissibly retracing the steps of the inventors with hindsight would lead one to arrive at the invention as claimed in the pending claims.

- III. In rejecting Claims 1-3, 5-6, 8-12, 14-15, 17-19, 22-23, 25-29 and 31 under 35 U.S.C. §103(a), the Final Office Action fails to consider the Cholet reference as a whole, as required by MPEP 2141.02(VI), when considering what a skilled artisan would take therefrom.

As argued previously in the Supplemental Appeal Brief, the Examiner's assertions fail to consider the disclosure of the Cholet '560 reference as a whole. The Cholet '560 reference discloses a permeability testing device for testing the permeability of a cigarette paper, and explicitly states that the disclosed permeability testing device and testing method is particularly applicable to "cellulose type fibre weave which consists of a succession of transverse segments of different densities and therefore of different permeability" whereby "the porous segments of the strip are not visible, and so it is not possible to initialise the position of the strip by a visual reference" because "the successive segments P1 and P2 of the strip cannot be distinguished visually. As a consequence, **the only option** for positioning of the strips **is to measure, point by point**, . . . the permeability of the strip along the longitudinal axis . . ."

As such, the Cholet '560 reference discloses a permeability testing device that first performs **a preliminary stage**, which comprises **a serial millimeter by millimeter permeability test along a paper to determine the periodicity of the bands** of different porosity levels. In this regard, the Cholet '560 reference notes that this is "**the only option for positioning of the strips**" (Paragraph [0025]). In the preliminary stage, a permeability profile is first determined, and a processor then determines a sinusoidal curve therefrom. The processor then determines the abscissa of the sinusoidal curve, from which an advancement of the strip is determined to provide the desired positioning for performing the permeability tests. That is, the determined periodicity is then used in **a measurement stage** by **the same permeability testing device** to perform the permeability tests along the paper. The permeability testing device disclosed by the Cholet '560 reference is thus used to run a first test to determine the periodicity of the bands of the paper, and then the same device is used to run a second test that uses the determined periodicity in order to perform the permeability tests along the paper.

The Examiner's Answer alleges that it would have been obvious to one of ordinary skill in the art to omit the detection procedure of the Cholet '560 reference as unnecessary and use the device of the Cholet '560 reference for the second porosity step. Examiner's Answer p. 11, lines 1-2. In this regard, the Examiner fails to consider the Cholet '560 reference as a whole. As a whole, the Cholet '560 reference **does not** teach or suggest implementing **separate and discrete** testing and pattern recognition devices, or a testing device configured to contemporaneously respond to a band detection signal generated by a pattern recognition device. In contrast, the Cholet '560 reference discloses a single permeability device, albeit a device with limitations (as described previously), for performing both periodicity tests and permeability tests along the paper.

Thus, when considered as a whole, the Cholet '560 reference **teaches away** from a combination with the Bokelman '218 patent. That is, one of ordinary skill in the art would not look to the disclosure of the Cholet '560 reference for guidance in modifying the inspection device of the Bokelman '218 patent because, if the Bokelman '218 patent teaches measuring properties of the paper such as spacing, width and contrast of the bands, then there would be no need for the device of the Cholet '560 patent. In other words, the device of the Cholet '560 reference would complicate the inspection device of the Bokelman '218 patent by providing a redundant measure for measuring properties of the paper; but to take the device of the Cholet '560 reference for only its ability to measure permeability is to not consider the reference as a whole, as required. Further, regarding the Examiner's allegation that one of ordinary skill in the art would omit the detection procedure of the Cholet '560 reference as unnecessary, the Applicants submit that this further shows that the Examiner has failed to consider the Cholet '560 reference as a whole. For such a combination, one of ordinary skill in the art would be required to deconstruct the device of the Cholet '560 reference and then select an arbitrary portion thereof to be combined with the Bokelman '218 patent, with no sufficiently objective reason for such a combination.

As such, the Applicants submit that the Bokelman '218, Cholet '560, and Seymour '547 references, either separately or in combination, **do not** teach, suggest, provide motivation for, or otherwise render predictable the embodiments of the present

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CONCLUSION

In summary, Bokelman, Cholet, Seymour and George, considered either alone or in any combination do not teach, suggest, provide motivation for, or otherwise render predictable the embodiments of the present invention, as claimed in Claims 1, 10, 18, 28, and the claims depending therefrom. Accordingly, it is submitted that the present invention, as defined by the pending claims, is patentable over the references cited in the Final Office Action mailed November 8, 2007. Accordingly, a decision from the Board of Patent Appeals and Interferences reversing the final rejection of the pending claims is earnestly solicited.

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Respectfully submitted,

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